

REMARKS

In the Office Action mailed May 7, 2007 from the United States Patent and Trademark Office, the Examiner rejected claims 1-6, 8-13, and 15-20 under 35 U.S.C. § 103(a) as being unpatentable over European Publication No. 0 484 145 (hereinafter “Kochis”) in view of U.S. Patent No. 6,487,611 to Brusky et al. (hereinafter “Brusky”), rejected claims 7 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Kochis and Brusky and further in view of allegedly admitted prior art, and rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Kochis and Brusky and further in view of U.S. Patent No. 5,937,150 to Phan (hereinafter “Phan”).

Rejections under 35 U.S.C. § 103(a):

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) Additionally, one helpful standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicant respectfully submits that the references cited by the Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that there is no suggestion or motivation to combine the references in the manner suggested by the Examiner, and that one of skill in the art would not reasonably expect any benefit or success in combining the references in the manner provided.

Independent claim 1 requires: “initiating a fax request at a computer device in communication with the multi-function peripheral, the computer device including a print subsystem having a print spooler,” “spooling a fax job corresponding to the fax request through the print subsystem of the computer device, wherein the fax job is constructed as a sequence of commands from a fax description language,” and “despooling the fax job to a printer port associated with the multi-functional peripheral.” Applicant respectfully submits that such limitations are not taught by the cited references, alone or in combination.

In the Office Action, the Examiner indicated that Kochis does not teach spooling a fax job corresponding to the fax request through a subsystem of a computer device, wherein the subsystem includes a print spooler, or despooling the fax job to a printer port associated with the multi-functional peripheral. The Examiner then cited column 4, lines 44-53 of Brusky as teaching spooling of scanned fax information in memory prior to transmitting the information to the peripheral for printing by a printer. The Examiner indicated that it would have been obvious to one of ordinary skill in the art to provide a memory for storing scanned image data, such as disclosed in Brusky, in the device taught in Kochis, so that any desired processing of the image, such as editing, may be performed. Applicant respectfully disagrees with the Examiner’s characterization of Brusky, and further disagrees that one of skill in the art would find it obvious

to combine the differing systems of Kochis and Brusky in the manner propounded by the Examiner.

Kochis is related to a system where a local computer sends a command to a local fax transmitting facility causing it to connect to a remote fax receiving facility. The computer then sends a file to the local fax transmitting facility, which sends the file to the remote fax receiving facility where the file is printed. (Col 2, lines 20-25) The file which is sent in the Kochis system is a non-standard fax file in that the file remains in a standard computer file format, such as ASCII, instead of being converted into a graphical image format, thus greatly reducing transmission time (the illustrated example is from 30-45 seconds to 2-3 seconds). (Col 1, lines 49-53; Col 2, lines 26-36) One having ordinary skill in the art will readily understand that the Kochis system does not correlate to facsimile transmission of a scanned document (which is in a graphical image format by nature), but instead relates to the facsimile transmission of a document in a much smaller standard format, such as the textual ASCII format.

In contrast, Brusky teaches a system that reduces the need for on-board memory and on-board processing on a multifunction peripheral device by transferring the memory and processing needs to an attached host computer device. (Abstract) The cited passage of Brusky does not teach applicant's claimed limitations of: "spooling a fax job corresponding to the fax request through the print subsystem of the computer device, wherein the fax job is constructed as a sequence of commands from a fax description language," and "despooling the fax job to a printer port associated with the multi-functional peripheral." The cited portion of Brusky merely teaches storing a scanned image into the computer's memory, altering the data, and sending the altered data to a printer in order to make a copy. (Col 4 lines 44-53, see also Col 4 lines 26-27 and line 37 showing that a copy function is being described.) Therefore, the cited portion of

Brusky clearly fails to teach applicant's claimed limitations, as the cited portions are dealing with a copy function, and do not teach spooling a fax job or despooling a fax job to a printer port.

In fact, Brusky clearly teaches away from Applicant's claimed limitations. A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness. M.P.E.P. § 2145; *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (emphasis added). In fact, it is improper to combine references where the references teach away from their combination. M.P.E.P. § 2145; *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Brusky discusses a fax function at column 5 line 66 through column 6 line 29. Most important, however, is the discussion of the storing and sending of fax data, where Brusky teaches that an image is scanned by the scanner (in the multifunction peripheral device 15), sent to memory in the computer host device 16, and is then transferred to a modem 56 in the host device 16 for transmission over a communications network without being sent back to the multifunction peripheral device. (Col 6 lines 19-27, see also Figure 3 for relative locations of referred-to devices within the peripheral device 15 and the host 16) Therefore, Brusky teaches against Applicant's claimed limitation of "despooling the fax job to a printer port associated with the multi-functional peripheral;" in the system of Brusky, the fax job is never returned to the multifunction peripheral device.

Therefore, as the Examiner has already acknowledged that Kochis does not teach the recited claim limitations, and as Brusky not only fails to teach the same claim limitations but also teaches against the claim limitations, it is clear that the claim limitations are not taught by the cited references, alone or in combination.

In addition, one of ordinary skill in the art would not combine the systems of Kochis and Brusky in the manner suggested by the Examiner, as one of ordinary skill in the art would

recognize that these systems are directed to different purposes and are unrelated. The mere fact that such prior art could theoretically be combined in a manner suggested by the Examiner does not render the presently-claimed invention obvious. Kochis is directed to a manner of transferring a file from one location to another by facsimile for printing, and therefore teaches the transmission of a non-scanned, non-graphical image format to the remote facsimile device. (Col 1, lines 49-53; Col 2, lines 26-36) As such, the file of Kochis is already in a textual, editable format, and is edited at the time it is created and before it is sent by facsimile to the remote location for printing. In contrast, Brusky teaches the transmission of a scanned document, which is inherently in a graphical image format that has limited capability for editing. (Col 6 lines 19-21)

Therefore, one of ordinary skill in the art would not think to combine the references in the manner suggested by the Examiner and would not expect success in achieving the benefit suggested by the Examiner of providing additional processing of image data, such as editing, as such is already available in the system of Kochis without the addition of Brusky. In fact, one of skill in the art would readily recognize that the system of Kochis provides improved editing capabilities over any system taught by Brusky. Therefore, for this additional reason, Applicant respectfully submits that claim 1 is not made obvious by the proposed combination of Kochis and Brusky.

Claims 12 and 17 contain similar limitations to those contained in claim 1 and discussed above. These claims are therefore similarly allowable. Claims 2-11, 13-16, and 18-21 depend from one of claims 1, 12 and 17, and are therefore also allowable. Therefore, for at least the reasons discussed above, namely that the cited references fail to teach all claim limitations and that one of ordinary skill in the art would not be motivated to combine the cited references in the

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manner suggested by the Examiner, Applicant respectfully requests the removal of all rejections

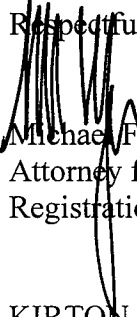
under 35 U.S.C. § 103(a).

CONCLUSION

Applicant(s) submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant(s) requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 2 day of August, 2007.

Respectfully submitted,


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